

REMARKS

Entry of the amendment is requested. The added claims encompass subject matter within the elected invention. The amendments to the claims are directed to the various rejections, and are discussed below.

SEQUENCE RULES

Applicants have amended the specification to refer to sequence information. In view of the extent of the changes, new pages have been submitted. Claims 59-70 are newly presented.

REJECTIONS UNDER 35 U.S.C. § 112, SECOND PARAGRAPH

The Examiner has rejected claim 40, and claims dependent thereon, for not reciting specific hybridization conditions. While applicants are of the view that amendment is not necessary, they have amended claim 40 to refer to conditions expressly recited in the specification.

With respect to the rejection of claim 46, while gDNA is standard terminology the “g” is spelled out as -- genomic -- to obviate this rejection.

Regarding the objection to claim 56, while applicants believe that “modulator” is very well defined in the specification and is clear to one of ordinary skill in the art, they have amended the claim such that this issue is now moot.

Applicants now turn to the rejection of claims 40-46, 48, 49, 51, 54, and 56, i.e., all of the claims considered by the Examiner as allegedly being non-enabled. The core of the Examiner’s rejection begins on page 6, and extends through page 7. Applicants have considered the rejection carefully, and traverse.

First, since applicants have amended the claims to recite the hybridization conditions, the issue allegedly raised by “the absence of a recitation of clear hybridization conditions” is no longer an issue.

The Examiner first alleges that sequence similarity less than 100% *de facto* raises a question as to biological activity, stating it is well known in the art that this is the case.

With respect to this position, applicants point out that the Examiner has not supplied any evidence to support her position, which in any event is overstated. It is well known, for example, that murine, rat, feline, canine, ursine, etc., molecules comparable to a human molecule will vary in sequence, but will have similar properties.

Second, it is black letter law that a claim does not have to be enabled for every molecule it covers. Experimentation is permissible to discover those which are enabled, as long as the experimentation is not undue.

The claims limit the scope of molecules embraced thereby with the hybridization language. Further, the specification teaches clearly and unambiguously how one of ordinary skill in the art could determine if a molecule which satisfies the structural characteristics of the claims, would also share the recited properties. Unquestionably, experimentation would be required; however, it is not undue experimentation.

Further, applicants provide evidence that molecules other than SEQ ID NO: 36 have the properties of SEQ ID NO: 36. The Examiner’s attention is directed to Example 17, at page 48 et seq., entitled “Inhibition of Osteoclast formation.” For example, mBP-m)CILrP (SEQ ID NO: 11), mBP-M0CILrP2 (SEQ ID NO: 15), and h0CIL (SEQ ID NO: 21), inhibited osteoclast formation. Table 5 at page 51, shows this for SEQ ID NO: 21. Also see figures 25 and 26 for evidence of the efficacy of the murine molecules.

Clearly, the generic statements made by the Examiner are rebutted by the evidence in the specification, if not the law and the objective scientific evidence. As such, it is believed that this rejection should be reconsidered; and withdrawn.

Regarding the specific rejection of claim 56, at page 7, claim 56 now refers to claim 54, which in turn refers back to claim 40, and thus is no longer subject to the issues raised by the Examiner.

Regarding the written description rejection which starts at page 8, the language “modulators of function or expression” has been deleted from the claims. Hence, this basis for rejection is moot. Further, as applicants have shown, *supra*, in order to envision the “detailed chemical structure of the encompassed polynucleotide or translated polypeptides,” all one has to do is review the sequence listings, as was shown *supra*. Neither of the cases relied upon by the Examiner to support her position, i.e., Fiers v. Revel, 25 USPQ2d 1601 (Fed. Cir. 1993), and Amgen, Inc. v. Chugai Pharmaceutical Co., Ltd., 18 USQPQ2d 1016 (Fed. Cir. 1991), is apposite, since in both cases, no molecules encompassed by the claims were disclosed. Such is clearly not the case here, and was shown, *supra*.

All rejections have been addressed and are believed to have been overcome. Hence, allowance of the application is believed proper.

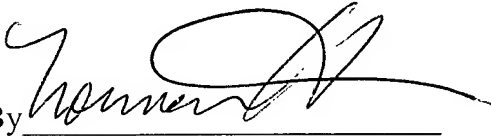
Application No. 10/031,902
Amendment dated February 20, 2007
Reply to Office Action of October 17, 2006

Docket No.: NY-HACK 206-US

Applicant hereby authorize the Commissioner to deduct the fee for the extension of time from our Deposit Account No. 50-0624, under Order No. NY-HACK 206-US (10203571) from which the undersigned is authorized to draw. Should any additional fees be required, please charge them to Deposit Account No. 50-0624.

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Respectfully submitted,

By 

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